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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,562	01/29/2002	Gerard Baccus	1759070	7954
7590	07/14/2004		EXAMINER	
Mary Louise Gioeni Heslin Rothenberg Farley & Mesiti P.C. 5 Columbia Circle Albany, NY 12203			PIERCE, JEREMY R	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/059,562	BACCUS ET AL.	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 03 May 2004.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 6-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 6-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08).  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Amendment***

1. Applicant's Amendment filed on May 3, 2004 has been entered. Claims 6, 11, and 12 have been amended.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on July 30, 1999. It is noted, however, that applicant has not filed a certified copy of the French application as required by 35 U.S.C. 119(b).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 6-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 6 recites "the thermoplastic polyolefin resin is separated from contact with bituminous material by the metal foil." Applicant argues that the new limitation is

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supported by the specification at page 4, lines 14-21. However, no support is found for the resin being separated from bituminous material. The specification only states that the bitumen-based composition is attached to the foil layer and does not penetrate the fibrous structure. Neither this language, nor the language of the claim (reciting the top layer comprises polyolefin resin) precludes the presence of bituminous material in the top layer. Applicant's limitation stating the resin is separated from contact with bituminous material is new matter.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites "the thermoplastic polyolefin resin is separated from contact with bituminous material by the metal foil." There is no antecedent basis for "bituminous material." The Examiner will assume that the "bituminous material" is the bituminous layer that is attached to the metal foil.

#### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gessner et al. (U.S. Patent No. 4,287,248) in view of Jackson (GB 1,095,393).

Gessner et al. disclose a roofing material comprising a textile backing combined with an aluminum foil that is coated on both sides with a bitumen coating (column 5, lines 54-68). Gessner et al. do not disclose that one coating side comprises a thermoplastic polyolefin resin. Jackson teaches that adding synthetic polymers, particularly polyethylene and polypropylene, to bitumen increases the flexibility of the bitumen at low temperatures (lines 72-78). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include polyolefin resin in the bituminous layers of Gessner et al. in order to increase flexibility of the roofing material, as taught by Jackson. With regard to Applicant's new limitation that the polyolefin resin be separated from bituminous material, the Examiner has interpreted this to mean the recited "bitumen layer," as set forth above in section 6. The bitumen layer bonded to the metal foil would be separated from the polyolefin resin in the top layer. With regard to claim 7, Gessner et al. teach one bitumen layer attached to the foil opposite the fabric side (column 5, lines 66-68). With regard to claim 8, Jackson discloses that polyethylene may be used (line 78). With regard to claim 9, Gessner et al. teach using aluminum foil (column 5, line 59).

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gessner et al. in view of Jackson as set forth above and further in view of Fullar (U.S. Patent No. 1,248,909).

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Gessner et al. does not teach the manner in which the bitumen is combined with the textile support. Fullar teaches that bitumen combined with a textile support may be calendered to create a final product where the bitumen thoroughly impregnates the fabric (page 2, lines 52-98). It would have been obvious to a person having ordinary skill in the art at the time of the invention to calender the bitumen roofing sheet of Gessner et al. in order to ensure a uniform thickness in the panel, as taught by Fullar.

10. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gessner et al. in view of Jackson as set forth above and further in view of Glassco et al. (U.S. Patent No. 4,879,850).

Gessner et al. fail to disclose using textile tape on the lateral edge of the roofing panel. However, use of such reinforcing tape is common in roofing panels, as shown in Glassco et al. (claims 1 and 5). It would have been obvious to a person having ordinary skill in the art at the time of the invention to reinforce the roofing panel with textile tape along the lateral edge in order to enable better bonding of the roofing panels when applying them to a roof, as taught by Glassco et al.

11. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gessner et al. in view of Jackson as set forth above and further in view of Kassner et al. (U.S. Patent No. 6,503,853).

Gessner et al. disclose that the fleece is reinforced, but do not disclose the textile to contain a fibrous web and a textile mesh. Kassner et al. disclose a textile layer for reinforcing bitumen. The textile layer comprises a fibrous web and a mesh material, which provides for increased strength (column 2, lines 15-56). It would have been

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obvious to a person having ordinary skill in the art at the time of the invention to use the textile of Kassner et al. in the bituminous product of Gessner et al. in order to provide increased strength to the roofing material, as taught by Kassner et al. With regard to claims 13 and 14, Kassner et al. teach using polymer and glass fibers (Abstract) and Gessner et al. teach using polyester and polyamide fibers (column 2, lines 19-24).

***Response to Arguments***

12. Applicant's arguments filed May 3, 2004 have been fully considered but they are not persuasive.

13. Applicant argues that Gessner is silent regarding a composite containing a polymer layer that is separated from contact with bitumen or a bituminous composition. However, Applicant does not claim a polymer layer separated from contact with bitumen. Applicant's top layer is claimed to comprise polyolefin resin, but other materials are not precluded from being present in the top layer, including bituminous material. The combination of references meets the current claim limitations. The term "bituminous material" has no antecedent basis in the claim, so the Examiner is interpreting it to mean the previously recited "bitumen layer," which is separated from the top layer by foil in the prior art. Although Applicant argues that the advantage of the present invention is the appearance and color of the material, such an advantage is not readily found in the current claim language.

***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ELIZABETH M. COLE  
PRIMARY EXAMINER